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EXAMINER	
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 09/987,886	Applicant(s) MATSUI ET AL.	
	Examiner DANIEL SORKOWITZ	Art Unit 3622	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *14 July 2009*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *13-18 and 32* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *13-18* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☒ Claim(s) *32* are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

Notice to Applicant

This Final Office action for application 09/987886 is in response to Applicant's response from 7/14/2009. Claims 13-18 have been examined. Claim 32 has been added by Applicant, and is subject to restriction and is withdrawn from consideration.

Election~Restrictions

Newly added claim 32 is directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: Originally filed claims 13-18 are directed towards system for distributing advertising selected by a user. In contrast, newly added claim 32 recites a separate and distinct invention which identifies a method for tailoring an advertisement based on user interest. Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claim 32 is withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP §821.03.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

1. **Claims 13-18 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.**

Regarding claim 13, this claim recites the limitation "a display displaying, on the user terminals, an advertisement requesting domain for accepting an advertisement distribution reservation". The claim is generally narrative and indefinite, failing to conform with current U.S. practice. It appears to be a literal translation into English from a foreign document and are replete with grammatical and idiomatic errors. It is unclear as to what the "domain" is meant to entail. Is the accepting of an advertisement referring to a hyperlink or a user click?
Is a domain a type of display window? Since it is unclear as to what applicant is intending to claim, the claim itself becomes indefinite. Is the user requesting to view advertising by clicking an icon.
Claims 14-18 inherit this rejection as each depends from claim 13.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –
(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. **Claims 13 and 17-18 are rejected under 35 U.S.C. 102 (b) as being anticipated by US Patent Number 5,794,210 to Goldhaber et al.**

Regarding claims 13 and 17-18, Goldhaber discloses an advertiser displaying its image to the users (figure 11 column 18 lines 34-55); displaying, on the user terminals, an icon for requesting an advertisement (figure 11 and figure 13 #304-310, column 18 lines 34-55, an advertisement requesting domain for accepting an advertisement distribution reservation referred to as an icon for requesting an advertisement); detecting that a user has selected or manipulated an icon to select an ad generating and transmitting ad request data to the advertiser corresponding to the relevant symbolic image; and displaying the advertisement and other images (column 9 line 53- 67 and column 10 lines 38-59).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

3. Claims 14-16 and 18 are rejected under 35 U.S.C. 103 (a) as being unpatentable over US Patent Number 5,794,210 to Goldhaber et al. in view of over US Patent Number 5,657049 to Ludolph et al.

Regarding claims 14-15 and 18, Goldhaber discloses transmitting ad request data to the advertiser corresponding to the relevant symbolic image; and displaying the advertisement (column 9 line 53- 67 and column 10 lines 38-59). Goldhaber does not disclose changing and managing the display position of an image in response to a user manipulation. However, Ludolph discloses detecting, saving, changing, and managing the display position of an image in response to a user manipulation (figure 9c and figure 10b #220, column 5 line 50- column 6 line 33 and column 22 lines 50-65). Therefore, it would have been obvious to one of ordinary skill at the time of the invention to combine Ludolph's method of icon manipulation with the icon selection method of Goldhaber. Moving icons to perform tasks such as selecting has been

used since before 1984 by the Apple Macintosh Computer to increase ease of user and fun and enjoyment by the user, e.g. dragging a file to the trash can is more fun than hitting the delete key. Further, Concerning the step of "determining whether an icon in which a manipulation is performed corresponds to the symbolic image included in the advertisement information and acquires, when the symbolic image is included in the advertisement information, the positional information relating to the symbolic image as the object of the relevant advertisement information existing in the relevant advertisement requesting domain "; that limitation is optional, and according to the MPEP, "language that suggests or makes optional but does not require steps to be performed or does not limit a claim to a particular structure does not limit the scope of a claim or claim limitation" (MPEP 2106.II. C).

Regarding claims 16, Goldhaber discloses transmitting ad request data to the advertiser corresponding to the relevant symbolic image; and displaying the advertisement (column 9 line 53- 67 and column 10 lines 38-59). Goldhaber does not disclose detecting whether other symbolic images already exist in the advertisement requesting domain and also transmits, when the other symbolic images are detected, information relating to the other symbolic images to the advertisement distributor. However, Ludolph discloses detecting, and changing display size of

images in a common area based on action to the window as a whole(column 18 lines 25-65). Therefore, it would have been obvious to one of ordinary skill at the time of the invention to combine Ludolph's method of group icon manipulation with the icon selection method of Goldhaber. Selecting all the items in a folder for a common operation is faster than having to select each item separately. Further, Concerning the step of " requesting unit detects whether other symbolic images already exist "; that limitation is optional, and according to the MPEP, "language that suggests or makes optional but does not require steps to be performed or does not limit a claim to a particular structure does not limit the scope of a claim or claim limitation" (MPEP 2106.II. C).

Response to Remarks/Arguments

This rejection has been amended to reflect the changes to the claim language and addresses any arguments submitted by the applicant. Therefore, the Examiner maintains the rejection to the Applicant's claims.

Applicant argues regarding the 112 2nd rejection for the term ""a display displaying, on the user terminals, an advertisement requesting domain for accepting an advertisement distribution reservation " that this feature is explicitly discussed in the specification on page 9 in paragraph

57". The Examiner disagrees. The language from the specification, "roughly classified" isn't appropriate to define the term, even if it was, there is no clear description for a "domain". This does not qualify as the "clear definition" required by MPEP § 2111.01: The specification does not establish the metes and bounds of the term . A clear definition must unambiguously establish what is and what is not included. A clear definition is indicated by a section labeled definitions, or by the use of phrases such as "by xxx we mean"; "xxx is defined as"; or "xxx includes, … but does not include …". The language " roughly classified " is not appropriate to define the term. In the instant case, the examiner is required to give the term its broadest reasonable interpretation (MPEP § 2111), which the examiner judges the term "an advertisement requesting domain for accepting an advertisement distribution reservation" to mean "an icon for requesting an advertisement".

Applicant argues regarding claim 13 that "The Office Action on page 6 incorrectly asserts that "an advertisement distribution reservation [is] referred to as an icon for requesting an advertisement." The Examiner disagrees. The Examiner has explained his 112 2nd rejection in the preceding paragraph, and has determined that the term "an advertisement requesting domain for accepting an advertisement distribution reservation" is interpreted to mean "an icon for requesting an

advertisement". The cited section of Goldhaber is believed to teach this element by disclosing detecting that a user has selected or manipulated an icon to select an ad generating and transmitting ad request data to the advertiser corresponding to the relevant symbolic image; and displaying the advertisement. Therefore, Examiner believes reference is still a reasonable teaching of the claimed invention in this regard, and the 102b rejection still stands.

Applicant argues regarding claim 15 that "the advertisement distribution reservation requesting unit transmits the distribution reservation requesting data to the advertisement distributor including the position of the symbolic image on the advertisement requesting domain and said information display displays the advertisement information adjusted depending on the position of symbolic image in the advertisement requesting domain from the information distributor… Ludolph and Goldhaber do not teach this feature". The Examiner disagrees. The cited section of Goldhaber teaches requesting a advertisement by clicking on an icon. The cited section of Ludolph teaches discloses detecting, saving, changing, and managing the display position of an image in response to a user manipulation. Therefore, Examiner believes the combined references are still a reasonable teaching of the claimed invention in this regard, and the 103 rejection still stands.

Applicant argues regarding claim 16 that “Goldhaber and Ludolph do not teach detecting whether other symbolic images are in the advertisement requesting domain and sending the information related to the other symbolic images to the advertisement distributor”. The Examiner disagrees. The cited section of Goldhaber teaches discloses transmitting ad request data to the advertiser corresponding to the relevant symbolic image; and displaying the advertisement . The cited section of Ludolph discloses detecting, and changing display size of images in a common area based on action to the window. Therefore, Examiner believes the combined references are still a reasonable teaching of the claimed invention in this regard, and the 103 rejection still stands. Applicant further argues “, the reference to MPEP 2106.11 C… is misplaced” and “the claimed features noted by the Office Action
are not optional”. The Examiner disagrees. The claim language of “transmits, when the other symbolic images are detected, is optional, only performed **“if** the advertisement distribution reservation requesting unit detects **whether** the images exist”. Therefore, the Examiner respectfully finds the Applicant’s argument unpersuasive.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to DANIEL SORKOWITZ whose telephone number is (571)270-5206. The examiner can normally be reached on M-F 8-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric W. Stamber can be reached on 571.272.6724.

The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free)? If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/D M S/
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